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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/146,835 09/03/98 ITO

M MAT-6280

EXAMINER

WM31/0404

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ART UNIT	PAPER NUMBER
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2622

*9*

DATE MAILED:

04/04/01

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

<b>Office Action Summary</b>	Application No. <b>09/146,835</b>	Applicant(s) <b>Ito et al</b>
	Examiner <b>Mark Wallerson</b>	Group Art Unit <b>2622</b>

Responsive to communication(s) filed on \_\_\_\_\_

This action is **FINAL**.

Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

#### Disposition of Claims

Claim(s) 1-33 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

Claim(s) \_\_\_\_\_ is/are allowed.

Claim(s) 1-9 and 23 is/are rejected.

Claim(s) \_\_\_\_\_ is/are objected to.

Claims 10-22 and 24-33 are subject to restriction or election requirement.

#### Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

The proposed drawing correction, filed on \_\_\_\_\_ is  approved  disapproved.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. § 119

Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All  Some\*  None of the CERTIFIED copies of the priority documents have been received.

received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

#### Attachment(s)

Notice of References Cited, PTO-892

Information Disclosure Statement(s), PTO-1449, Paper No(s). 5, 6, 7

Interview Summary, PTO-413

Notice of Draftsperson's Patent Drawing Review, PTO-948

Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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### **Part III DETAILED ACTION**

#### **Notice to Applicant(s)**

1. This application has been examined. Claims 1-33 are pending.

#### ***Priority***

2. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

#### ***Information Disclosure Statement***

3. The references listed in the Information Disclosure Statements dated 9/30/98, 5/21/99, and 10/4/99 have been considered by the Examiner and is attached to this Office Action.

#### ***Election/Restriction***

4. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-9, and 23, drawn to digital cameras, classified in class 348, subclass 64.
  - II. Claims 10-21, and 25-33, drawn to photographic printing, classified in class 358, subclass 1.16.
  - III. Claims 22 and 24, drawn to a display system, classified in class 345, subclass 328.
5. Inventions I, II, and III are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be

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separately usable. In the instant case, invention I has separate utility such as storing picture information into a removable memory of a digital camera, while invention II has separate utility such as printing information stored in a removable memory, while invention III has separate utility such as displaying information in a removable memory. See MPEP § 806.05(d).

6. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

7. Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Groups II and III, restriction for examination purposes as indicated is proper.

8. During a telephone conversation with Lawrence Ashery on 3/26/01 and 3/29/01 a provisional election was made without traverse to prosecute the invention of Group I, claims 1-9 and 23. Affirmation of this election must be made by applicant in replying to this Office action. Claims 10-22 and 24-33 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

9. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

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***Claim Rejections - 35 USC § 102***

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. Claims 1 and 23 are rejected under 35 U.S.C. 102(b) as being anticipated by Saito (U. S. 5,153,729).

With respect to claims 1 and 23, Saito discloses a digital camera comprising a removable nonvolatile memory (the abstract, lines 1-2); picture taking means for storing picture information in the memory (the abstract, lines 1-7 and column 3, lines 38-43); picture selecting means (column 4, lines 15-21 and lines 44-51); storing a processing method for the selected picture (column 4, lines 37-44); performing transmission according to the stored information (column 5, lines 39-43).

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

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13. Claims 1, 2, 3, 4, 5, 6, and 23 are rejected under 35 U.S.C. 102(e) as being anticipated by Lourette et. al. (hereinafter referred to as Lourette) (U. S. 5,978,016).

With respect to claims 1 and 23, Lourette discloses an electronic camera comprising a removable nonvolatile memory (the abstract, lines 1-15, and column 8, lines 48-54); picture taking means (column 6, lines 1-18) for storing information in the memory (column 10, lines 2-16); means for selecting a picture (column 10, lines 5-16), and means for storing a processing method for each selected picture in the memory (column 5, lines 46-59, and column 16, lines 10-28).

With regard to claims 2 and 4, Lourette discloses the picture selecting means is for selecting the picture to be transmitted and printed (in the photofinisher), and the stored information relates to the transmission and printing of the picture (column 17, lines 35-56).

With respect to claim 3, Lourette discloses the picture selecting means is for selecting the picture to be displayed, and the stored information relates to the display of the picture (column 15, lines 15-64).

With regard to claim 5, Lourette discloses the processing control information storage means stores a processing instruction string (which reads on information specific to the digital images) (column 5, lines 63-66).

With respect to claim 6, Lourette discloses selecting a picture corresponding to the order person and information corresponding to the order person (column 17, lines 4-56 and column 19, lines 1-15).

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***Claim Rejections - 35 USC § 103***

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. Claims 7, 8, and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lourette in view of Petruchik et. al. (hereinafter referred to as Petruchik) (U. S. 5,619,738).

With respect to claims 7, 8, and 9, Lourette differs from claims 7, 8, and 9 in that he does not clearly disclose storing information about a rotation angle of the picture. Petruchik discloses means for storing print orientation information (column 5, lines 58-67). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Lourette to store information about a rotation angle of the picture. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Lourette by the teaching of Petruchik in order to more easily define the exposure.

**Conclusion**

16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U. S. Patent 6,160,577 is cited as it discloses storing images and order information in a memory card.

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17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark Wallerson whose telephone number is (703) 305-8581.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-4700.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks  
Washington, DC 20231

or faxed to:

(703) 308-9051 (for formal communications intended for entry)

(703) 305-9731 (for informal or draft communications, such as proposed amendments to be discussed at an interview; please label such communications "PROPOSED" or "DRAFT")

or hand-carried to:

Crystal Park Two  
2121 Crystal Drive  
Arlington, VA.  
Sixth Floor (Receptionist)

MARK WALLERSON  
PATENT EXAMINER

MARK WALLERSON